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Filing Date

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First Named Inventor

Stephen G. PERLMAN

Art Unit

2173

Examiner Name

Brian J. Detwiler

Attorney Docket Number

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- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
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- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/Incomplete Application
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Date

October 13, 2005

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43,403

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

**Stephen G. Perlman et al.**

Confirmation No. 2377

Application No. 09/818,175

Filed: March 26, 2001

For: **APPARATUS AND METHOD FOR  
SELECTING DATA**

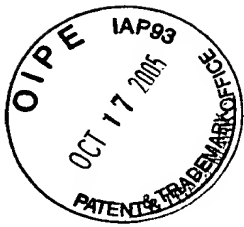
Group Art Unit: 2173

Examiner: Brian J. Detwiler

**REPLY BRIEF**

TO THE COMMISSIONER FOR PATENTS:

The Applicants submits this *Reply Brief*, pursuant to 37 C.F.R. § 41.41, in response to the *Examiner's Answer* mailed August 26, 2005, and in support of Applicants' *Appeal Brief* filed June 8, 2005.



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## INTRODUCTION

The claims on appeal refer to “an entertainment system” and more particularly to “selecting a multimedia program within an entertainment system.” The salient portion of the claims relate to “providing a potential list of second words for the multimedia program . . . based, at least in part, on how frequently a multimedia program . . . has been played.” The cited references do not teach or suggest providing second words based on “how frequently a multimedia program . . . has been played.” Instead, the cited references teach providing second words based on collective popularity among a large number of people, such as mass consumers using an online merchant system. Providing second words based on collective popularity among a large number of people is not the same as providing second words based on how frequently a multimedia program . . . has been played at a given entertainment system. The *Examiner’s Answer* contends that they are either the same thing or that knowledge of the former would teach one of ordinary skill in the art the latter. The Applicants disagree for the reasons stated below as well as in the Applicants’ *Appeal Brief*.

## II. ARGUMENTS

### A. Ortega and Beach Do Not Teach Suggesting a Second Word Based on “How Frequently a Multimedia Program . . . Has Been Played by the Entertainment System.”

Ortega’s teaching that a list of autocompletion strings can be ordered based on mass consumer popularity does not teach or suggest that such strings, as they might relate to words of a multimedia program within an entertainment system, can be ordered based on how frequently a multimedia program whose name includes those words has been played at the entertainment system.

The *Examiner’s Answer* continues to attribute to the references a teaching that the “potential list of second words [are] selected, at least in part, on how frequently a multimedia program . . . has been played by the entertainment system” – when the references together suggest no such thing. The *Examiner’s Answer* correctly states that Ortega teaches ordering a list of potential second words based on a particular measure of “how frequently the items are accessed or viewed by users” (quoting Ex. Ans. at page 4, lines 5-6.) While that much is true, the *Examiner’s Answer* is incorrect when it goes on to state:

This feature, furthermore, is not limited to any particular interface genre. It can be used in any auto-completing graphical user interface where it would be

advantageous to present titles according to how likely a user is to select each of the titles. (Ex. Ans. at page 4, lines 8-10.)

Ortega's teaching of popularity-based ordering of a second word is, in fact, limited to the particular genre of online merchant systems with which Ortega is solely concerned. As explained on pages 4-8 of the Applicants' *Appeal Brief*, Ortega's system is an online merchant system for selling merchandise to mass consumers over the Internet, and Ortega's concept of popularity – that is, broad-based popularity among a large population of diversely located consumers – is fundamentally different from “how frequently a multimedia program . . . has been played by the entertainment system,” notwithstanding the fact that Ortega may describe its particular notion of popularity using broad terms such as “most popular,” “best selling,” or “most frequently viewed.” (See Ortega's Abstract.) The *Examiner's Answer* persists in emphasizing this superficially similar language even though the underlying concepts are significantly dissimilar.

**B. That Multiple Individuals May Use the Claimed “Entertainment System” Does Not Render the Claims Obvious Over Ortega and Beach.**

The *Examiner's Answer* notes that the Applicants' entertainment system is not “limited to one particular user” and that the claimed “invention only requires that the multimedia programs be played on a single entertainment system.” (Ex. Ans. at page 8, lines 1-3.) The *Examiner's Answer* goes on to contend that, because Ortega's online merchant system similarly engages multiple users, the differences between Ortega and the claimed inventions are slight. The Applicants disagree with that conclusion.

Whether one, two, or a greater number of individuals play multimedia programs at a given entertainment system, that playback history has special significance to those individuals and to that and only that entertainment system, as it reflects those individual(s)' program preferences, favorite programs, and viewing patterns – all of which correlate to those individual(s)' likely desire for the next program selection. The same is not true of Ortega's system. As the *Examiner's Answer* recognizes, Ortega's system includes “numerous client devices” (Ex. Ans. at page 8, line 4)\*, and Ortega's concept of popularity is

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\* The Examiner's Answer incorrectly characterizes Ortega's system on page 9, lines 12-13 as “reflect[ing] the browsing activities and items of interest of one or more users.” Ortega does not disclose any case in which only one user's browsing activities and items are reflected. All embodiments disclosed by Ortega involve a large number of users.

a broad-based popularity among a diverse set of consumers or potential consumers, each typically at a different client device. Unlike the claimed inventions, which operate with respect to a single given entertainment system, Ortega's scheme collects data from a large number of different client devices to determine an aggregate, collective popularity score. Ortega's approach is a reasonable one for selling merchandise to mass consumers, but that approach is fundamentally incompatible with the notion of suggesting a program based on its frequency of playback at one particular entertainment system. A given consumer is likely to buy merchandise that many other consumers have found fit to purchase, but that is a different decision making factor from individual(s)' selecting multimedia programs to play at one particular entertainment system based on how frequently programs have been played in the past at the very same entertainment system.

**C. Going From Ortega's Broad-Based Notions of Collective Popularity to the Claimed Concept of "How Frequently a Multimedia Program . . . Has Been Played By [a Given] Entertainment System" is Based on Impermissible Hindsight.**

In restating the grounds for rejection of the independent claims, the *Examiner's Answer* repeats the same hindsight reconstruction of the invention that the Examiner has adhered to. In particular, the *Examiner's Answer* states that the motivation for combining Ortega and Beach in the manner asserted by the Office would have been exactly the motivation that the Applicants – and only the Applicants – have taught:

It would have been beneficial to do this [providing a potential list of second words for a multimedia program wherein the list is based, at least in part, on how frequently a multimedia program whose name includes one of the second words has been played by the entertainment system] because the multimedia programs that have been played more frequently are more likely to be selected by the user as supported by Ortega. (Ex. Ans. at page 4, lines 15-17.)

As explained above and in the Applicants' *Appeal Brief*, Ortega does not support that notion. Ortega does not teach a link between frequency of playback and likelihood of selection of the next multimedia program. Only the Applicants' own specification teaches that link. Ortega teaches a different link – a link between mass consumer popularity of a merchandise and the likelihood that another consumer will wish to purchase that merchandise.

Fairly considered, Ortega and Beach together suggest to one skilled in the art that an entertainment system connected to a larger network could suggest potential second words of

multimedia program titles based on the mass popularity of those programs. However, that is not what the Applicants have claimed in this application. To make the leap from that type of system to the ones claimed by the Applicant – *i.e.*, ones in which the potential second words are suggested based on how frequently the programs have been played at the particular entertainment system where the selection is being made – is to engage in impermissible hindsight reconstruction of the Applicants' own work.

While it is true that Ortega teaches the general goal of reducing the number of keystrokes a user must enter to make a merchandise selection, that goal is not motivation for one skilled in the art to arrive at the Applicants' particular basis for second word suggestions (*i.e.*, how frequently a program has been played at a given entertainment system) as opposed to any other basis for suggesting second words to a user. Any motivation to use the particular basis claimed by the Applicants is absent from the prior art, is taken entirely from the Applicants' own teachings, and therefore constitutes impermissible hindsight.

### III. CONCLUSION

For all of the foregoing reasons as well as those stated in the Applicants' *Appeal Brief*, the Examiner has not made out a *prima facie* case of obviousness, and the Board should therefore reverse the rejection of all claims.

Respectfully submitted,

Digeo, Inc.

Date: October 13, 2005

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